

5
JUDGE CARTER

17 CV 3422

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

| | | |
|---------------------------------|---|---------------------|
| ROBERT G. LOPEZ, an individual, |) | |
| |) | |
| Plaintiff, |) | |
| |) | |
| v. |) | Civil Action No. |
| |) | |
| WAL-MART STORES, INC. |) | JURY TRIAL DEMANDED |
| |) | |
| Defendant. |) | |

U.S. DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK
CLERK'S OFFICE
CIVIL NO. 17-CV-3422

**COMPLAINT FOR TRADEMARK INFRINGEMENT,
UNFAIR COMPETITION AND RELATED CLAIMS**

Plaintiff, Robert G. Lopez, alleges his complaint against Defendant, Wal-Mart Stores, Inc., as follows:

NATURE OF THE ACTION

1. This action arises from Defendant's infringement of Plaintiff's "ownership" and exclusive "use" rights in the marks, LOWER EAST SIDE™ and LES NYC®, in conjunction with clothing and related goods. Despite Plaintiff being the registered owner of the trademark LOWER EAST SIDE™ and LES NYC® and offering various clothing items under such brand names, the Defendant has infringed Plaintiff's rights in the aforementioned marks by promoting, selling, and offering for sale clothing items under Plaintiff's trademarks. Plaintiff has already experienced "actual confusion" in connection with this matter and is likely to continue to experience confusion as to the affiliation or connection between the Defendant and Plaintiff resulting in the unjust enrichment of Defendant by using Plaintiff's registered trademarks.

JURISDICTION AND VENUE

2. This Court has jurisdiction over this action pursuant to 15 U.S.C. §1051 *et seq.*, 15 U.S.C. Sections 1114-1116; under Section 43(a) of the Trademark Act, 15 U.S.C. §1125(a) and Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c).

3. This Court has personal jurisdiction over the Defendant because Defendant engages in continuous and significant business activities in, and directed to the State of New York within this judicial district and is registered with the NYS Department of State Division of Corporations to do business in New York and because Defendant has committed tortious acts aimed at and causing harm within the State of New York and this judicial district.

4. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391(b) and (c) because it is where Plaintiff resides and the Defendant transacts business and/or maintains an office or business location in this district, and because a substantial portion of the events giving rise to the asserted claims have occurred, and continue to occur, within this district. Furthermore, the damage to Plaintiff and its intellectual property described herein continues to occur in this judicial district.

THE PARTIES

5. Plaintiff, Robert G. Lopez is an individual residing at 230 Clinton Street, Apt. #11C, New York, NY 10002.

6. Upon information and belief, Defendant Wal-Mart Stores, Inc. is a Delaware corporation with a principal place of business at 702 SW 8th Street, Bentonville, Arkansas 72716.

FACTS

7. Since at least as early as 1999, Plaintiff Robert G. Lopez has been selling headwear, t-shirts, sweaters, hooded sweatshirts and other clothing items under the LOWER EAST SIDE™ and LES NYC® brand names.

8. Since at least as early as 1999, Plaintiff has been independently operating a clothing business under the trade name L.E.S. CLOTHING CO.™, which has sold headwear, t-shirts, sweaters, hooded sweatshirts and other related clothing items under the marks LOWER EAST SIDE™, and LES NYC®. Since at least as early as 2010, Plaintiff has also been selling clothing items under the mark LOYALTY EQUALS STRENGTH™ which is an additional representation of the LES™ acronym stands for and represents.

9. In addition to selling and offering for sale clothing items under the LOWER EAST SIDE™, LES NYC®, LES™ and LOYALTY EQUALS STRENGTH™ brand names. Plaintiff has also continuously sold and offered for sale various clothing items including hooded sweatshirts and t-shirts which bear the THE LOWER™, LOWER EAST SIDE™ and LES NYC® marks in various font and design styles which are prominently displayed on the front and/or back of the headwear, t-shirts and/or sweaters as well as printed on hang tags, clothing labels, stickers and on clothing product packaging materials.

10. Plaintiff sells, and promotes the sale of his clothing via his website www.lesclothing.com, through order forms, and his t-shirts and sweaters are also available for sale in several retail locations in New York and other States. From 2012 to 2015 Plaintiff also maintained a Flagship LES Clothing Co. store located at 43 Clinton Street, New York, NY 10002.

11. Plaintiff advertises his LES CLOTHING CO™, LOWER EAST SIDE™, THE LOWER™ and LES NYC® brands and clothing items through flyers, posters, stickers and through grass root street marketing methods such as painted “street murals.” Plaintiff also

regularly conducts photo shoots of customers who purchase his **LOWER EAST SIDE™** and **LES NYC®** clothing items to be included in magazine advertisements and other marketing materials.

12. The **LOWER EAST SIDE™** brand and mark has acquired “secondary meaning” in the marketplace in connection with the sale and offering of clothing goods based on Plaintiff’s continuous and long standing use of the mark in the apparel industry.

13. Plaintiff is the registered owner of New York State Trademark Registration No. R31067 and R32849 both for the mark **LOWER EAST SIDE™**. (See Exhibit A).

14. Plaintiff is the registered owner of United States Trademark Registration No. 4,549,880 for the mark **LES NYC®** which is the abbreviation and/or acronym for the mark **LOWER EAST SIDE NEW YORK CITY™** and **LOYALTY EQUALS STRENGTH NEW YORK CITY**. (See Exhibit B).

15. The mark **LOWER EAST SIDE®** is a federally registered trademark under United States Trademark Registration No. 2,416,437 that has been rendered “incontestable” under Section 15 of the Trademark Act and is therefore not open to challenge as to its function as a trademark and brand name as it has been in continuous use as a brand name in excess of fifteen (15) years. (See Exhibit C).

16. Plaintiff has a Co-Existence Agreement with Payless Shoesource Worldwide, Inc. who is the owner of United States Trademark Registration No. 2,416,437 for the mark **LOWER EAST SIDE®**, which allows the parties to co-exist in the marketplace and both utilize the **LOWER EAST SIDE** mark but limits Payless’s use of the mark to “**footwear**” and grants and/or limits Plaintiff’s rights in the **LOWER EAST SIDE™** mark to “**t-shirts, sweaters, headwear**” and all other forms of clothing that exclude footwear.

17. Plaintiff is informed and believes and thereon alleges that Defendant is marketing, promoting, selling and offering for sale a t-shirt bearing Plaintiff's **LOWER EAST SIDE™** mark. (See Exhibit D).

18. Plaintiff was been contacted by several long-standing customer of his **LES CLOTHING CO™ LOWER EAST SIDE™** and **LES NYC®** clothing products regarding the **LOWER EAST SIDE™** brand products that are offered and sold at Defendant's thinking the products were sponsored and/or affiliated with Plaintiff and his business LES Clothing Co.

19. Defendant's use of Plaintiff's **LOWER EAST SIDE™** and/or **LES NYC®** brands in connection with clothing has already caused and will continue to cause confusion as to the source or affiliation of the source of the clothing related goods bearing the **LOWER EAST SIDE™** and **LES NYC®** marks.

20. Defendants business status as a major retailer of apparel and related goods also has the capability of causing reverse confusion where consumers of clothing products will think that all **LOWER EAST SIDE™** clothing related products are sponsored or produced by Defendant.

FIRST CAUSE OF ACTION
TRADEMARK INFRINGEMENT (15 U.S.C. §§ 1114-1116)

21. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 20 of this Complaint.

22. The use in commerce by Defendant of an identical and slightly identical version of Plaintiff's registered trademark is likely to cause confusion, mistake and deception among members of the public and in trade as to the source, origin, or sponsorship of defendants' goods and services. Such use by defendant constitutes a clear and direct infringement of Plaintiff's rights in and to Plaintiff's registered trademark, and has resulted in injury and damage to Plaintiff

that will continue if Defendant is not ordered to cease all use of the **LES NYC®** and **LOWER EAST SIDE™** marks.

SECOND CAUSE OF ACTION

UNFAIR COMPETITION & FALSE DESIGNATION OF ORIGIN (15 U.S.C. § 1125(a))

23. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 22 of this Complaint.

24. Plaintiff has the exclusive right to market, brand and provide clothing related goods using the **LES NYC®** and **LOWER EAST SIDE™** marks.

25. Defendant by reason of the aforementioned acts, have falsely described, represented and designated the origin of its goods and services. Defendants' activities already have confused the public into believing that Defendants and Plaintiff's clothing goods and accessories come from one and the same source, and defendants continued activities are likely to create further confusion and deceive the public concerning the source of the goods/services.

26. Defendant have unfairly profited from the actions alleged herein and will continue to unfairly profit and become unjustly enriched unless and until such conduct is enjoined by this Court.

27. By reason of Defendant's willful acts conducted in conscious disregard for Plaintiff's rights, Plaintiff is entitled to treble damages under 15 U.S.C. § 1117(a).

THIRD CAUSE OF ACTION

COMMON LAW TRADEMARK INFRINGEMENT & UNFAIR COMPETITION

28. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 27 of this Complaint.

29. Defendant's conduct constitutes deception by which Defendant goods will be palmed off as those of Plaintiff. Such conduct constitutes trademark infringement and unfair competition in violation of the laws of the State of New York.

30. Defendant's unauthorized use of Plaintiff's LOWER EAST SIDE™ and LES NYC® marks is likely to continue to cause further confusion to the public as to the clothing goods and accessories of the respective parties.

31. By reason of the foregoing, Defendant has infringed and continues to infringe on Plaintiff's common law rights in the **LOWER EAST SIDE™** and **LES NYC®** marks and Defendant has become unjustly enriched by such acts of infringement.

32. Defendant's unlawful conduct has been and will continue to be willful or willfully blind to Plaintiff's rights, as Defendant has reason to know of Plaintiff's rights.

FOURTH CAUSE OF ACTION
UNJUST ENRICHMENT

33. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 32 of this Complaint.

34. Defendant has unjustly retained profits from the sale of clothing goods and accessories bearing Plaintiff's **LOWER EAST SIDE™** and/or **LES NYC®** marks.

35. Defendant's actions constitute unjust enrichment.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully prays for relief as follows:

1. Entry of an order and judgment requiring that all defendant, its subsidiaries, officers, agents, servants, employees, owners, and representatives, and all other persons or

entities in active concert or participation with them, be preliminarily and, thereafter, permanently enjoined and restrained from (a) using in any manner the trade name, trademark, domain name or other indicia or origin, including in whole or part the term **LOWER EAST SIDE™, LES NYC®**, or any colorable imitation thereof; (b) advertising, operating a website, using business stationary or offering any goods or services using the trade name, trademark, domain name, URL, or any other indicia of origin including in whole or part the term **LES NYC®**, or any colorable imitation thereof; (c) otherwise engaging in any acts of unfair competition and infringement which tend to injure Plaintiff's rights in the **LES NYC®** mark.

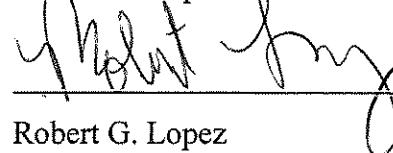
2. That Defendant be required to account to Plaintiff for any and all profits derived by it, and to compensate Plaintiff for all the damages sustained by reason of the acts complained of herein, and that the damages herein be trebled pursuant to the Trademark Act.
3. That Defendant be ordered to deliver up for destruction any and all infringing materials bearing the **LOWER EAST SIDE™** and **LES NYC®** marks, and any colorable imitation thereof, in whole or part.
4. That Plaintiff be awarded punitive damages.
5. That Defendant be required to place advertisements or send notifications to past and present customers that it improperly has been using the **LOWER EAST SIDE™** and/or **LES NYC®** marks.
6. That Plaintiff be awarded statutory damages in the amount of \$5,000,000.00 for Defendant's acts of willful infringement.
7. That Plaintiff be awarded the cost and disbursements of this action.
8. That Plaintiff have such other and further relief as the Court deems just and proper.

JURY DEMAND

Pursuant to Federal Rule of Civil Procedure 38(b), Plaintiff hereby demands a trial by jury as to all issues.

Dated: May 8, 2017
New York, New York

Respectfully submitted,
Robert G. Lopez – Pro Se



Robert G. Lopez
Pro Se Plaintiff
230 Clinton Street – Apt. #11C
New York, New York 10002
(917) 868-1698

EXHIBIT A

New York State Department of State Certificate of Trademark Registration

I Daniel E. Shapiro, Special Deputy Secretary of State, do certify that the Trademark described below and depicted on the attached copy has been duly registered in this Department pursuant to Article 24 of the General Business Law. This registration will remain in force for TEN years from the Date of Registration.

Registration Number: R31067

Registration Date: 06/06/07

Applicant: ROBERT G. LOPEZ
230 CLINTON STREET APT. #11C
NEW YORK

NY 10002-

*State of Incorporation or
Partnership Organization:*

Class Numbers: 25

Date First Used in NYS: 12/1999

Date First Used Anywhere 12/1999

Trademark Description:

LOWER EAST SIDE

The mark is comprised of the words "Lower East Side" In stylized letters with an underline and overline.

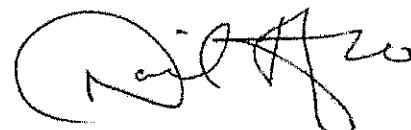
Description of Goods:

Clothing, namely, T-shirts, Hooded Sweatshirts, Vest, Hats and Caps as adopted from the USPTO.

*WITNESS my hand and the seal of the State of New York In
the City of Albany on this:*

Thursday, August 16, 2007

by:



Special Deputy Secretary of State

New York State Department of State Certificate of Trademark Registration

I, Anthony Giardina, Executive Deputy Secretary of State, do certify that the Trademark described below and depicted on the attached copy has been duly registered in this Department pursuant to Article 24 of the General Business Law. This registration will remain in force for TEN years from the Date of Registration.

Registration Number: R32849 **Registration Date:** 08/09/16

Applicant: **ROBERT G. LOPEZ**
230 CLINTON ST. - APT. 11C
NEW YORK NY 10002-

***State of Incorporation or
Partnership Organization:***

Class Numbers: 25

Date First Used in NYS: 12/01/1999 **Date First Used Anywhere:** 12/01/1999

Trademark Description:

The mark is comprised of the words LOWER EAST SIDE without claim to any particular font, style or design.

Description of Goods: *Clothing, namely; t-shirts, sweaters, shorts and headwear.*

WITNESS my hand and the seal of the State of New York In
the City of Albany on this:

Thursday, August 11, 2016

by:



Executive Deputy Secretary of State

EXHIBIT B

United States of America
United States Patent and Trademark Office

LES NYC

Reg. No. 4,549,880

LOPEZ, ROBERT G. (UNITED STATES INDIVIDUAL)
230 CLINTON STREET - APT. #11C
NEW YORK, NY 10002

Registered June 17, 2014

Int. Cl.: 25

FOR: BASEBALL CAPS AND HATS; HOODED SWEATSHIRTS; SHORT-SLEEVED OR LONG-SLEEVED T-SHIRTS; T-SHIRTS, IN CLASS 25 (U.S. CLS. 22 AND 39).

TRADEMARK

FIRST USE 12-0-1999; IN COMMERCE 12-0-1999.

PRINCIPAL REGISTER

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SEC. 2(F).

SER. NO. 85-335,314, FILED 6-1-2011.

ALICE BENMAMAN, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

EXHIBIT C



United States Patent and Trademark Office

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LOWER EAST SIDE

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| Word Mark | LOWER EAST SIDE |
| Goods and Services | IC 025. US 022 039. G & S: Footwear. FIRST USE: 19990616. FIRST USE IN COMMERCE: 19990616 |
| Mark Drawing Code | (1) TYPED DRAWING |
| Serial Number | 75652553 |
| Filing Date | March 3, 1999 |
| Current Basis | 1A |
| Original Filing Basis | 1B |
| Published for Opposition | November 30, 1999 |
| Registration Number | 2416437 |
| International Registration Number | 1220106 |
| Registration Date | December 26, 2000 |
| Owner | (REGISTRANT) PAYLESS SHOESOURCE WORLDWIDE, INC. CORPORATION KANSAS Jayhawk Towers 700 SW Jackson Topeka KANSAS 66603 |
| Assignment Recorded | ASSIGNMENT RECORDED |
| Attorney of Record | ROBERT CARROLL |
| Prior Registrations | 1795922 |
| Type of Mark | TRADEMARK |
| Register | PRINCIPAL |
| Affidavit Text | SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20110108. |
| Renewal | 1ST RENEWAL 20110108 |

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 2,416,437

Registered Dec. 26, 2000

**TRADEMARK
PRINCIPAL REGISTER**

LOWER EAST SIDE

PAYLESS SHOESOURCE WORLDWIDE, INC. (KAN-
SAS CORPORATION)
JAYHAWK TOWERS
700 SW JACKSON
TOPEKA, KS 66603

FOR: FOOTWEAR, IN CLASS 25 (U.S. CLS. 22
AND 39).

FIRST USE 6-16-1999; IN COMMERCE 6-16-1999.
OWNER OF U.S. REG. NO. 1,795,922.
SN 75-652,553, FILED 3-3-1999.

TANYA AMOS, EXAMINING ATTORNEY

EXHIBIT D



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